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| BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840 | | | ART UNIT 3625 | PAPER NUMBER |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,779

Applicant(s)

STERN ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant amended Claims 1, 2, 4, 7, 15-25, 27, 28, 32, 35-37, 41, 42, 44, 46, 47, 51, 52, 54-63, 65-68, 70, 72, 75, 76, 80, 81, 85, 86, 89, 90, 93-97, 99, 101, 102, 104, and 106. All pending claims (1-112) were examined in this final office action necessitated by amendment.

Response to Arguments

Rejection under 35 USC 103(a)

Applicant's arguments filed 10 January 2005 have been fully considered but they are not persuasive.

- The Examiner's reasoning for modifying Intacta is proper. It is a form of Official Notice. Intacta teaches Intacta code capable of being transmitted by e-mail as cited by Intacta (W: see page 2).
- The Examiner recognizes the claimed invention as pertaining to an image of an item identifier that is captured locally, transmitted from the local location for making a determination of item information associated with an item associated with the item identifier. Though not relied upon and intending no disrespect to the Applicant's invention, if one peels back the technological uplift of the instant application, old and well known trivial use of technology can accomplish at least Claims 1, 15, 41, and 55: a

consumer possessing an advertisement containing a company's brand product name or product logo or other promotional information and instructions transmits the promotional item via fax (please note: capturing locally an image or images of an item identifier) to a remote location (please note: to the advertiser or sponsor or seller). The recipient receiving the faxed item image(s) makes a determination based on the communication- sends product information to the consumer, takes an order, etc. Before e-mail became mainstream, this was a popular mode of conducting business- buyer faxes information to a seller and the seller responds back to the buyer with information pertinent to the received identifying information. This is an old and well known method of conducting business between remotely connected buyer-seller entities.

- Adding well known fax server technology at the recipient's end eliminates manual collection of received faxes (e.g. RightFax as used by the Patent Office). A recipient can use a computer to make the determination and respond.
- Employing old and well known optical character recognition software can at least code textual item identifiers (e.g. URL addresses) that can be automatically linked (prior art).
- The Applicant asserts that Intacta teaches away from the claimed invention. The Examiner recognizes that applying Intacta code to achieve the claimed invention may be applying it for a trivial technological task

relative to Intacta, but if Intacta can be used to decode a matrix of dot patterns (black or color) to ascertain the encoded complex content it clearly can decode a matrix of dots (please note: inkjet printers, laser printers, digital cameras create images using a matrix of dots to produce an image) that have limited encoded value other than an indirect reference to information pertaining to the scanned item identifier. Intacta code can be transmitted via a bit mapped graphic, fax, e-mail, or hand-delivered as a print-out. Consumers can fax the Intacta image or email the image to anyone with Intacta decoding software in order to receive the desired information.

- Press releases containing forward looking statements are typical corporate boilerplate disclaimers used to protect the company or companies issuing a press release from lawsuits should the anticipated results of using patented technology not be fully achieved. It is not the intent of the disclaimer to suggest to each reader that they now possess original thought regarding the disclosed business methods described in the press release. This non-patent literature fully discloses to readers business methods using patented technology with an expectation of success. The disclaimer does not disqualify the use of Item U or other non-patent literature cited by the Examiner.
- Regarding rejection of Claims 10-14, 50-54, and 84-88, the Examiner respectfully disagrees with the Applicant for the reasons noted above.

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- Regarding rejection of Claims 18, 19, 58, 59, 92, and 93, the Examiner respectfully disagrees with the Applicant for the reasons noted above.

Official Notice (regarding promotional offers) Claims 10-14, 50-54, and 84-88

The Applicant did not traverse the examiner's assertion of official notice on the merit specific to the official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-9, 15-17, 20-49, 55-57, 60-83, 89-91, and 94-112 are rejected under 35 USC 103(a) as being unpatentable over Intacta (a collection of prior art cited in PTO-892, Items: U-W).**

Intacta teaches producing scannable codes that in one case take readers to Web sites and in another supply the content directly. Intacta teaches the system and method of Intacta Technologies of providing printed images of dots, black or

color, that contains encoded information, and scanning the image with any standard scanner into a computer to decode item information or identifiers used to present item information to a user (U: see at least page 1; V: see at least page 1; W: see at least pages 1-3). Intacta teaches Intacta code can be transmitted via a bit mapped graphic, fax, e-mail, or hand-delivered as a print-out (please note examiner's interpretation: a consumer in possession of printed Intacta code can fax the print-out to a recipient capable of decoding Intacta code). Intacta further teaches:

- Receiving an image of an item identifier; capturing image: using any standard scanner a users scans printed INTACTA.CODE™ into a computer (please note: scanner captures image); printed INTACTA.CODE™ is an image of printed dots onto a media (U: see at least page 1). Encoded image contains item information or identifiers for item information (W: see at least page 1-3). Please note examiner's interpretation: consumer receiving media containing Intacta code taking the action of scanning is doing so based on information that explains at least what the customer must do to receive the desired content or information).
- Determining, based on the received image, item information associated with an item identified by the item identifier: scanned image is decoded to the original application, music file, or graphic; (U: see at least page 1); used as a background in a graphic or instead of solid black in a big

headline, the code can be used to call up additional information-the full text of a speech, a translation, or a sound file (W: see pages 2-3).

- Transmitting the image: image transmitted as a bitmap graphic (W: see at least page 2).
- Wireless devices: INTACTA.CODE™ supports device handling on any number of handheld platforms, including Windows CE, Palm OS, and WAP (Wireless Application Protocol) (U: see at least page 3); competing companies supporting wireless devices (e.g. wireless hand scanner, wireless wand) (W: see at least page 4).
- Image is received from a device: computer receives image from scanner (please note examiner's interpretation: computer-scanner combination is a first device) (U: see at least page 2);
- Transmitting the item information to the device: image is decoded to produce text, music, color graphics, or executable computer application (W: see at least page 2); decoded image can take the user to web sites in a fashion similar to small scannable bar codes (e.g. Japanese readers use the code to connect to baseball teams' web sites); Identification code represent URL that connect to web sites (U: see at least page 3). Please note examiner's interpretation: decoded image contains URL to connect to web site which displays to the device a baseball team's item information.
- Translating the received image into an identification code: image is decoded to produce text, music, color graphics, or executable computer

application (W: see at least page 2); decoded image can take the user to web sites in a fashion similar to small scannable bar codes (e.g. Japanese readers use the code to connect to baseball teams' web sites);

Identification code represents URL that connects to web sites (U: see at least page 3). Please note examiner's interpretation: decoded image contains URL, an identification code, to connect to web site (please note examiner's interpretation: another computer device) that displays to the device a baseball team's web page.

- Identifying the item information as being associated with the identification code: URL is associated with item information (W: see page 3); used as a background in a graphic or instead of solid black in a big headline, the code can be used to call up additional information-the full text of a speech, a translation, or a sound file (W: see pages 2-3). Please note examiner's interpretation: item information is associated with the identification code used to call up the item information and returns item information back to the device.
- Item identifier comprises at least one of: text; others include music, color graphics, or executable computer application; item identifier is a URL (W: see at least pages 2 and 3).
- Item identifier is an element of a promotional offer: image or coded box used to bring extra information to printed ads (W: see at least page 3).

- Item information comprises at least one of: executable code of free software printed on a newspaper (U: see at least page 1).
- Item information comprise software for conducting optical character recognition: decoded information can be executable software; "virtually any software, including music files, high-resolution graphics or any executable computer application can be delivered using the technology (U: see at least page 2).
- Determining a type of the received image: data represented by the spots can be any sort of text, music, color graphics, or executable computer application and remains in native format (W: see at least page 2). Inherent in INTACTA.CODE™ is determining type of the received image.
- Determining a method to obtain item information based on the type: decoded image taking a user to a web site; calling up additional information-the full text of a speech, a translation, or a sound file (W: see pages 2-3). Inherent in INACTRA.CODE™ is determining a method to obtain item information based on the type.
- Item identifier is located proximate to a location: encoded subscriber information placed on the delivery label to be scanned (W: see at least page 2).
- Receiving payment from a seller of the item; payment is based on a number of times the image is received: Intacta charging a seller per-use fee (W: see page 2).

- Payment is based on an increase in the seller's revenue: Intacta is paid ongoing fees (W: see at least page 2).

Intacta teaches all the above as noted under the 103(a) rejection and teaches a) scanning an image into a user's computer, b) a user computer communicating a decoded INTACTA.CODE™ image to a provider's web site to receive item information from the provider's web site (please note examiner's interpretation: a client/server interaction), c) a user scanning the encoded subscriber information on a newspaper delivery label for an online advertiser site or service, and d) transmitting the image as an email attachment, but does not specifically disclose a sever receiving the image and determining the item information. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Intacta to disclose the user emailing the image to a provider's web site, since one of ordinary skill in the art would ascertain the web site server being capable of decoding the image and retrieving item information for the user.

2. **Claims 10-14, 50-54, and 84-88 are rejected under 35 USC 103(a) as being unpatentable over Intacta (a collection of prior art cited in PTO-892, Items: U-W), in view of Official Notice (regarding promotional offers), further in view of Business Wire (PTO-892, Item: WW hereinafter referred to as "BW").**

Intacta teaches all the above as noted under the 103(a) rejection and teaches providing promotional offers via encoded INTACTA.CODE™ images, but does

not disclose an expiration date. The Examiner takes the position that it is old and well-known that promotional offers typically indicate an expiration date to indicate finality for the offer and thereby encourage action. Therefore it would have been obvious to one of ordinary skill in the art at time of invention to modify the method of Intacta to disclose an expiration date as taught by Official Notice, in order to communicate to the user how long the promotional offer will last, and thereby encourage the user to take action.

Intacta and Official Notice teach all the above as noted under the 103(a) rejection and teach a) encoding promotional offers with expiration dates using INTACTA.CODE™, b) online providers making promotional offers using INTACTA.CODE™, c) using Palm devices to scan images, and d) Intacta technology used to reproduce numerical data in a spreadsheet form (please note examiner's interpretation: a traditional calendar is numerical data in spreadsheet form) (V: see page 2), but does not disclose recording an expiration date in a calendar. BW teaches a service provider providing calendar synchronization services that allows a user to synchronize an online calendar with the user's Microsoft Outlook and Palm devices. BW further teaches the provider sending reminders directly to the user's desktop, mobile devices, or pagers (please note examiner's interpretation: sending the user reminders that a calendar event is about to expire is equivalent to counting down for the user) (WW: see at least pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Intacta and Official Notice to

implement recording an expiration date in a user's calendar and sending reminders as taught by BW, in order to encourage the Intacta user to take action on the promotional offer.

- 3. Claims 18, 19, 58, 59, 92, and 93 are rejected under 35 USC 103(a) as being unpatentable over Intacta (a collection of prior art cited in PTO-892, Items: U-W), in view of PR Newswire (PTO-892, Item: X, hereinafter referred to as "PRN1").**

Intacta teaches all the above as noted under the 103(a) rejection and teaches a) a first device scanning an image, decoding the item identifier that takes the user to a provider's web site, the web site retrieving the item information, and sending item information back to the first device, b) scanning and transmitting an image to server, and c) small foot print devices (e.g. Palm) used to scan Intacta images and bar codes, but does not disclose transmitting the item information to a second device. PRN1 teaches Intacta Technologies conducting a demonstration that shows their technology can provide persons with print disabilities electronic access to any printed document. PRN1 further teaches the technology providing an economical way to reach any visually impaired reader (X: see pages 1-2). It would have been obvious to one of ordinary skill in the art at time of the invention to disclose transmitting item information to a second device, since one of ordinary skill in the art would ascertain that displaying

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retrieved item information on a small footprint first device would not be beneficial to the visually impaired user.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
April 2, 2005